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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,627	09/16/2003	Dan Kesner Carter	29370.35	1924
27683	7590	04/06/2005	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			LEVI, DAMEON E	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/663,627

**Applicant(s)**

CARTER ET AL.

**Examiner**

Dameon E. Levi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09/16/2003 New Application.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimada et al US Patent 5873738.**

**Regarding claim 1**, Shimada et al discloses an assembly comprising:

a chassis(for example, see element 1, Figs 1-9)

an embedded backplane(for example, see element 1, Figs 1-9) positioned within the chassis and adapted to receive a plurality of daughter boards; and

a replaceable module (for example, see element 42, Figs 1-9)positioned proximate to the embedded backplane and adapted to receive the daughter boards,

wherein the system is modifiable depending on a selected characteristic of the replaceable module(for example, see column 3, lines 50-60, Figs 1-9).

Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claim 2**, Shimada et al discloses wherein the chassis is adapted for receiving both the embedded backplane and the replaceable module(for example ,see Figs 1,4). Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of

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record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claim 3**, Shimada et al discloses wherein the embedded backplane is positioned between the daughter boards and the replaceable module(for example ,see elements 43, 4, 6, Figs 1,4).

**Regarding claim 4**, Shimada et al discloses wherein at least one of the daughter boards includes a connector(for example ,see elements 4,2, Figs 1,4) adapted to extend through the embedded backplane and into the replaceable module. Moreover the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claim 5**, Shimada et al discloses wherein the embedded backplane includes a plurality of openings, and wherein the replaceable module is configured to receive the daughter boards via the plurality of openings(for example ,see elements 6,42, Figs 1,4).

**Regarding claim 6**, Shimada et al discloses wherein the chassis includes an opening (for example ,see elements 1,42, Figs 1,4)proximate to the embedded backplane for accessing the replaceable module.

**Regarding claim 7**, Shimada et al discloses wherein at least one of the daughter boards includes a first connector(for example ,see elements 3 Figs 1,4) adapted to connect to the embedded backplane and a second connector(for example ,see elements 2, Figs 1,4) adapted to connect to the replaceable module.

**Regarding claim 8**, Shimada et al discloses wherein the embedded backplane is in signal communication with the replacement module(for example, see Fig 1).

**Regarding claim 9**, Shimada et al discloses wherein the replaceable module is a replaceable backplane, and wherein the selected characteristic of the replaceable backplane provides the system with additional bandwidth(for example, see column 7, lines 10-30).

**Regarding claim 10**, Shimada et al discloses wherein the replaceable backplane includes a plurality of general purpose slots, wherein each general purpose slot is adapted to receive a daughter board(for example, see Figs 1,4). Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claim 11**, Shimada et al discloses further comprising a router card connected to one of the general purpose slots(for example, see element 4, Figs 1,4) wherein router card is adapted to control the flow of data through the replaceable module. Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Claims 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Annapareddy et al US Patent 5603044.**

**Regarding claim 13**, Annapareddy et al discloses an apparatus comprising:

a body portion, wherein the body portion includes a plurality of data paths(for example, see element 12, 44,42, Fig 1); a plurality of connections in communication with the data paths(for example, see elements C,D, Fig 1); for connecting at least one of the data paths to one or more printed circuit boards; and alignments means (for example, see Figs 1,2, ); for positioning the module with respect to the backplane.

**Regarding claim 14**, Annapareddy et al discloses wherein the connections are positioned on the module to correspond to openings in the embedded backplane(for example, see elements C,D, Fig 1).

**Regarding claim 15**, Annapareddy et al discloses further comprising:

a plurality of printed circuit boards in signal communication with the connections(for example, see elements 14, Fig 2); and at least one router board, wherein the router board is attached to each printed circuit board via at least one data path(for example, see elements 60 Fig 2).

**Regarding claim 16**, Annapareddy et al discloses wherein the router board is attached to each printed circuit board via first and second data paths(for example, see elements A,B, C, D Fig 2), wherein the first data path is adapted to transfer data from the printed circuit board to the router board, and wherein the second data path is adapted to transfer data from the router board to the printed circuit board(for example, see column 4, lines 63-67). Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the

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prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claim 17**, Annapareddy et al discloses wherein the first and second data paths each comprise a pair of signal lines(for example, see signal lines connected to elements A,B, C, D Figs 1, 2).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 12, and 18-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada et al US Patent 5873738 in view of Annapareddy et al US Patent 5603044.**

**Regarding claim 12**, Shimada et al discloses the instant claimed invention except wherein the replaceable module further includes first and second sets of data transfer paths connecting each general purpose slot and the router card, wherein the first set of data transfer paths is adapted to transfer data from each general purpose slot to the router card, and wherein the second set is configured to transfer data from the router card to each general purpose slot.

Annapareddy et al discloses an apparatus wherein a replaceable module further includes first and second sets of data transfer paths connecting each general purpose

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slot and a router card, wherein the first set of data transfer paths is adapted to transfer data from each general purpose slot to the router card, and wherein the second set is configured to transfer data from the router card to each general purpose slot (for example, see Figs 1,2, see column 4, lines 63-67).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included data transfer paths for the router card and the connection slot as taught by Annapareddy et al in the assembly as taught by Shimada et al as such arrangements are necessary to provide high speed communication signal switching during operation of the device. Moreover the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability so to do. However, the prior art of record is deemed as possessing the claimed ability since the elements for performing the function are taught therein.

**Regarding claims 18-20**, methods disclosed therein are deemed inherent in the assembly of the claimed apparatus since the elements used for facilitating the methods are taught and suggested in the prior art of record. The claims are thus subsequently rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dameon E. Levi whose telephone number is (571) 272-2105. The examiner can normally be reached on Mon.-Fri. (9:00 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on (571) 272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dameon E Levi  
Examiner  
Art Unit 2841

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SUPERVISORY EXAMINER